

Applicant : Yaakov Naparstek
Serial No. : 09/826,069
Filed : April 4, 2001
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Remarks

Claims 8-14 are pending in the subject application.

Claim 14 Is Entitled To March 20, 1997 Filing Date, Is Not Subject To Any Rejection Of Record, And Is Allowable.

Applicant's July 27, 2006 Amendment on page 4 pointed out that claim 14 is supported by portions of the disclosure originating in a parent application having a March 20, 1997 priority date. Specifically, claim 14 is supported, *inter alia*, by page 4, lines 29-32; page 11, line 21 to page 12, line 14; and Figures 5, 6, 7 and 9 of the subject application. It is well settled that claims "fully supported under 35 U.S.C. 112 by the earlier parent application have the effective filing date of that earlier parent application." M.P.E.P. §706.02(v)(B).

Because the sole rejection of claim 14 is an obviousness rejection relying on references dated after March 20, 1997, claim 14 is improperly included in that rejection.

In the September 8, 2006 Final Office Action, the Examiner does not contest that claim 14 is entitled to the March 20, 1997 effective filing date. Claim 14 is nonetheless included in the obviousness rejection based on post-March 20, 1997 references. This is improper. The post-March 20, 1997 references of the obviousness rejection cannot impact the patentability of claim 14 having a March 20, 1997 effective filing date.

Accordingly, claim 14 is not subject to any rejection of record and is understood to be allowable. A formal

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indication of allowance of claim 14 is respectfully requested.

To expedite prosecution, the undersigned had attempted to contact Examiner Ewoldt by telephone to resolve the improper inclusion of claim 14 in the obviousness rejection. The undersigned left a message on the Examiner's telephone voice mail service on February 28, 2007 requesting an opportunity to have a telephone interview with the Examiner. As of the filing of this Amendment, the Examiner has not responded to the undersigned's message. Applicants are filing this Amendment by facsimile and kindly request the Examiner to confirm to the undersigned that claim 14 is allowable at the earliest opportunity by telephone at the number indicated below.

Point #1 of Applicant's July 27, 2007 Reply Has Not Been Addressed, thus Requiring Withdrawal of the Rejection.

In the September 8, 2006 Final Office Action, the Examiner maintained the rejection of claims 8-10, and added to the rejection claims 11-14*, under 35 U.S.C. §103(a) as allegedly unpatentable over Gaubitz, M., et al., Journal of Autoimmunity, (1999), 11:495-501 ("Gaubitz") in view of U.S. Patent No. 6,228,363, issued May 8, 2001 (Naparstek) with a priority date of March 20, 1998 ("the '363 patent") and Madaio, M., et al., Journal of the American Society of Nephrology, (1996), 7:387-396 ("Madaio").

* As noted herein, claim 14 has been improperly included in this rejection.

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The Examiner stated the Applicant's July 27, 2007 arguments have been fully considered but found them unpersuasive.

While Applicant maintains all of its arguments of record, noting that there is disagreement between the Examiner and Applicant, Applicant will focus this after final response on the one issue that remains unaddressed on this record. Applicant maintains that the record continues to lack an explanation of how the combined disclosure of the cited references teach the element of "extracorporeal treatment of plasma ... by affinity absorption column chromatography, wherein the column comprises [or as in claim 11: consists essentially of] a peptide having an amino acid sequence as set forth in SEQ. ID. NO. 1."

Specifically, nothing of record teaches or even suggests the extracorporeal removal of antibodies that bind to a peptide represented by SEQ ID NO. 1. Applicant has pointed out this deficiency of the obviousness rejection in his July 27, 2007 reply. The September 8, 2006 "final" Office Action on page 3 acknowledged that Applicant has pointed out the deficiency. In attempting to rebut Applicant's contention that this is a deficiency in the combined disclosure of the cited art, the September 8, 2006 "final" Office Action cites to various sections of the M.P.E.P. and concludes on page 4 that "the MPEP teaches the use of 'logic and sound reasoning'." However, the September 8, 2006 "final" Office Action does not offer an explanation, directly or by reference, of how the combined teaching of the cited art purportedly suggests extracorporeal removal of antibodies that bind to a peptide represented by SEQ ID NO. 1.

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Applicant respectfully submits that maintenance of the obviousness rejection is improper on this record. "Logic and sound reasoning" cannot supplant the fact that the peptide of SEQ ID NO. 1 (R38 peptide) is only disclosed in the cited references for administration to a patient. Nowhere do the cited references suggest selecting the R38 peptide to place on a column, or removing from a patient antibodies that bind the R38 peptide.

Applicant note the reference in the September 8, 2006 "final" Office Action to M.P.E.P. §2144 for the preposition that "[T]he rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law." Applicant first notes that the September 8, 2006 final Office Action does not explain which theory the obviousness rejection relies on. Furthermore, Applicant respectfully points out that if the rejection is relying on "established scientific principles," M.P.E.P. § 2144.02 requires "evidentiary support" for the principles. No evidentiary support has been provided. If the rejection is relying on "knowledge generally available to one of ordinary skill in the art," M.P.E.P. § 2144.03 requires such reasoning to be "judiciously applied" and requires a specific procedure to be followed when being applied as outlined in M.P.E.P. §§2144.03(A) - (E). No such procedure has been followed in the September 8, 2006 final Office Action.

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Accordingly, applicant maintain his position that, in the absence of applicant's disclosure of extracorporeal removal of antibodies that bind the R38 peptide, one of skill in the art would understand the R38 peptide to be useful for administration to lupus patients as disclosed in the '363 patent. It is only in hindsight with the benefit of applicant's disclosure that the Examiner has come to believe the R38 peptide may be used in a column for extracorporeal removal of anti-R38 antibodies. The combination of cited references clearly lacks this element of the claimed invention, as evidenced by the lack in this record of a single reference to any portion of the art suggesting the element.

The rejection based on Gaubitz et al., the '363 patent, and Madaio et al. is therefore improper and should be withdrawn.

For the record, Applicant maintains all of his arguments previously set forth against the obviousness rejection.

Rejection of Claim 11 Under 35 U.S.C. § 112, 1st paragraph

On page 6 of the September 8, 2006 final Office Action, the Examiner rejected claim 11 under 35 U.S.C. § 112, 1st paragraph, as allegedly introducing new matter. Examiner paraphrased claim 11 and concluded that the specification does not support claim 11.

Applicant respectfully disagrees. Except for its transitional phrase "consists essentially of," claim 11 is otherwise identical to claim 9 which has not been

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objected to. Both claims are supported literally by the specification, e.g. on page 5, lines 3-8, and exemplified on page 18, line 3 to page 19, line 10 as explained in the support section of Applicant's July 27, 2006 Amendment. Claim 11 is, thus, fully supported by the subject specification.

Accordingly, Applicant respectfully request the Examiner to reconsider and withdraw this rejection.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee other than the \$1,020.00 fee for the three-month extension of time herein authorized to be charged to Deposit Account No 03-3125, is deemed necessary. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

Gary J. Gershik
John P. White
Registration No. 28,678
Gary J. Gershik
Registration No. 39,992
Attorneys for Applicant
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400